

REMARKS

Claims 45-69 are cancelled. New claims 70-83 are added.

Claims 50-52, 56-57, 62-63 and 66-67 stand withdrawn as being directed toward a non-elected invention. The Examiner indicates at page 3 of the present Action that a complete reply to the final rejection must include cancellation of such claims. Without admission as to the propriety of the Examiner's requirement, claims 50-52, 56-57, 62-63 and 66-67 are cancelled, with preservation of the right to re-enter claims directed toward the subject matter of these cancelled claims upon allowance of a generic or linking claim in accordance with MPEP § 809.

Claims 46, 53 and 59 stand objected to "for reciting on non-elected inventions". Applicant notes that such claims are linking or generic and are not required to be amended to exclude non-elected inventions (see MPEP § 809). Applicant notes that claims 46, 53 and 59 are cancelled without admission as to the propriety of any rejection of such claims. Noting that new claims 70 and 81 are also linking claims, applicant notes that "linking claims must be examined with the invention elected" (MPEP § 809).

Claims 45-49, 53-55, 58-61, 64-65 and 68-69 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The Examiner indicates that dependent claims are rejected as depending from a rejected base claim. The Examiner further asserts that recited phrase "defining a set of controlled conditions" has not been defined and renders the claims unclear. The Examiner's statements further indicate that "collecting" has not been defined, that the recited "mustard" is unclear, that the recited "a crop of transgenic plants" is unclear, that "inducible by an inducing condition" is

unclear and "value" is unclear. It is also asserted that the meets and bounds of "hydroponic system" and "aerosol delivery system" have not been defined. Without admission as to any of the Examiner's statements, claims 45-49, 53-55, 58-61, 64-65 and 68-69 are cancelled, and newly presented claims 70-84 are written in such a way as to not recite any of the above indicated terms in the manner utilized in the previous claims.

The former claims considered by the Examiner are indicated in the present Action to be either anticipated by or rendered obvious by various individual and cited combinations of the following references: Rose, U.S. Patent No. 861,277; Thiele (Plant Physiology 120:73-81, 1999); Fladung (Plant Molecular Biology 23:749-757); Soper, U.S. Patent No. 5,920,002; and Dehesh, U.S. Patent No. 5,850,022. The Examiner is reminded by direction to MPEP §2131 that anticipation requires each and every element of a claim to be disclosed in a single prior art reference. The Examiner is further reminded by direction to MPEP § 2143 that a proper obviousness rejection has the following three requirements: 1) there must be some suggestion or motivation to modify or combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the combined references must teach or suggest all of the claim limitations. As indicated above, the previously pending claims are cancelled without prejudice. Newly presented claims 70-84 are allowable over the cited art for at least the reason that the references, individually or as combined, fail to disclose or suggest each and every limitation in any of those claims.

New claim 70 recites a method of producing a protein of interest by introducing an inducible promoter operably linked to a coding sequence, and cultivation the host during which time the transgenic plant is exposed to an amount of an environmental factor that both induces expression of the protein in a portion of a plant and enhances growth of the

portion of the plant. The portion of the plant is harvested and protein is collected from the harvested portion of the plant. The references cited in the present Action, individually or as combined, do not disclose or suggest the claim 70 recited utilization of an inducible promoter, exposing to a controlled amount of environmental factor that both induces the expression from the promoter and enhances growth the portion of the plant where the protein is expressed, harvesting the portion of the plant, and collecting the protein from the harvested portion. Accordingly, claim 70 is not rendered obvious by Rose, Thiele, Fladung, Soper and Dehesh and is allowable over these references.

New claims 71-80 are allowable over the cited references for at least the reason that they depend from allowable base claim 70.

Independent claim 81 recites a method of producing a protein of interest in a potato plant where a potato plant host is transformed with an inducible promoter operably linked to a coding sequence. The transgenic potato is grown under conditions where exposure to an environmental factor capable of inducing the promoter is controlled. The transgenic potato is exposed to an amount of the environmental factor which induces expression of the protein of interest in the plant foliage, the plant foliage is harvested and the protein of interest is collected from the plant foliage. The cited art references, individually or as combined, do not disclose or suggest the claim 80 recited collecting protein of interest from plant foliage of a transgenic potato plant. Accordingly, independent claim 80 is not rendered obvious by Rose, Thiele, Fladung, Soper and Dehesh and is allowable over these references.

Dependent claims 82-84 are allowable over the cited art for at least the reason that they depend from allowable base claim 81.

Applicant respectfully requests examination of new claims 70-84.

Respectfully submitted,

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